

Atty. Docket No. PURP01/0010

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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MAR 24 2004

OFFICIAL

In re Application of:	)	Art Unit:	3728
LOUIS J. PANACCIONE	)	Examiner:	M. Patterson
Serial No. 10/086,509	)		
Filed: 28 February 2002	)		
For: MODULAR CUSHIONED	)		
INSOLE SUPPORT SYSTEM	)		

**PETITION UNDER 37 C.F.R. § 1.181**  
**TO WITHDRAW HOLDING OF ABANDONMENT**

Assistant Commissioner for Patents  
 Washington, D.C. 20231

Sir:

This petition is to withdraw the holding of abandonment noticed as of 23 January 2004. It is believed that no fee is due for this petition.

**REMARKS**

A Notice of Abandonment dated 23 January 2004 was received in this case. The reason for abandonment was failure to reply to the Office Action dated 16 June 2003. However, Applicant submitted via telefax a *bona fide* response to that Office Action on 25 September 2003 and received an "Auto-Reply Facsimile Transmission" from the Office immediately following. However, following receipt of the Notice of Abandonment, I was advised that due to a clerical error in completing the fee transmittal, the one-month extension of time fee due for that submission was not charged to my credit card. A declaration under Rule 132 in support of these facts is enclosed, together with a copy of the original submission.

It is requested that the holding of abandonment be withdrawn and prosecution on the merits resumed. The required one-month extension of time fee is paid herewith. Applicant believes that the application as amended is in condition for allowance and respectfully requests such action.

23 March 2004

396 Washington Street, Suite 322  
 Wellesley, MA 02481  
 781.237.2858

0010-2/PUR-P01/Rule 181 Pctr23mar04

Respectfully submitted,

*Timothy J. Shea II*  
 Timothy J. Shea II, Esq.  
 Reg. No. 37,504

RECEIVED  
 MAR 24 2004  
 OIPE/JCWS

Atty. Docket No. PURP01/0010

In re: Application of:	)	Art Unit:	3728
LOUIS J. PANACCIONE	)	Examiner:	M. Patterson
Serial No. 10/086,509	)		
Filed: 28 February 2002	)		
For: MODULAR CUSHIONED	)		
INSOLE SUPPORT SYSTEM	)		

**RULE 132 DECLARATION OF TIMOTHY J. SHEA II**

I, TIMOTHY J. SHEA II, a United States citizen, having a business address of 396 Washington Street, Suite 322, Wellesley, Massachusetts 02481, declare that:

1. I am a registered patent attorney, Reg. No. 37,504, and am the attorney of record in the above identified application.
2. On 25 September 2003, I submitted a *bona fide* Office Action response to the then-outstanding Office Action letter dated 16 June 2003. A copy of this response is attached as Exhibit 1.
3. This response and accompanying transmittal papers was successfully submitted via telefax at 18:30 hours, as indicated by the confirmation page generated by my telefax machine. A copy of this confirmation page is attached as Exhibit 2.
4. Immediately following this submission, I received an "Auto-Reply Facsimile Transmission" from the Office. A copy of this confirmation page is attached as Exhibit 3.
5. Following receipt of the Notice of Abandonment, I was notified that due to a clerical error in completing the fee transmittal, the additional \$55 fee for the one-month

extension of time due for the response was not charged to my credit card. A new fee transmittal and Form PTO-2038 to cover that fee is enclosed herewith.

\* \* \*

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both under Section 1001 of Title 18 of the United State Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: 23 March 2004


  
Timothy J. Shea II

EXHIBIT 1

**TIMOTHY J. SHEA II, ESQ.**  
REGISTERED PATENT ATTORNEY

396 Washington Street, Suite 322 - Wellesley, MA 02481  
781.237.2858 781.237.3557 telefax  
Email: timothy.shea@comcast.net

***Facsimile Cover Sheet***

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*Date:* 23 March 2004

*To:* M.Patterson  
U.S.P.T.O. Art Unit 3728

*Telefax No.:* 1.703.872.9302

*From:* Timothy J. Shea II, Esq.

*U.S.S.N.:* 10/086,509

*Atty. Docket No.:* PURP01/0010

*Pages (including this page):* 30

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Atty Docket No. PURP01/0010

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	Art Unit: 3728
LOUIS J. PANACCIONE	)	Examiner: M. D. Patterson
Serial No. 10/086,509	)	
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For: MODULAR CUSHIONED	)	
INSOLE SUPPORT SYSTEM	)	

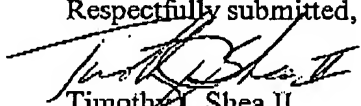
CERTIFICATE OF TRANSMISSION  
UNDER 37 C.F.R. 1.08

Date of Transmission: 23 March 2004

Identification of paper or fee: Rule 181 Petition, Rule 132 Declaration and Exhibits, Fee Transmittal, Form PTO-2038 *call customer no response*

I hereby certify that the above-identified paper to which this certification is attached is being transmitted by facsimile to the Patent and Trademark Office under 37 C.F.R. 1.8(a) in accordance with 37 C.F.R. §1.6(d) on the date indicated above and addressed to the Assistant Commissioner for Trademarks, Washington, D.C. 20231.

Respectfully submitted,

  
Timothy J. Shea II  
Reg. No. 37,504

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Wellesley, MA 02481  
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0010-2/PUR-P01/cert/023mar04

PTO-017 (08-03)

Approved for use through 07/01/2006. OMB 0625-0032  
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

By the Federal Acquisition Regulation Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**FEE TRANSMITTAL**  
**for FY 2003**

Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27.TOTAL AMOUNT OF PAYMENT (\$)  
(\$)  
55.00**Complete if Known**

Application Number	10/086,504
Filing Date	28 February 2003
First Named Inventor	Louis J. Maccione
Examiner Name	M. D. Peterson
Art Unit	5728
Attorney Docket No.	100P01/0010

**METHOD OF PAYMENT (check all that apply)**
☐ Check ☒ Credit card ☐ Money Order ☐ Other ☐ None
☐ Deposit Account

Deposited Account	
Deposited Account	
Deposited Account	
Deposited Account	
Deposited Account	

The Director is authorized to receive all that apply:

☒ I agree to pay under a bill of exchange ☐ I credit my overpayments.☐ I agree to pay additional fees during the prosecution of this application.☐ I agree to pay additional fees, except for the filing fee.☐ I agree to pay additional fees, except for the filing fee.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 250	2001 375	Utility filing fee	
1002 300	2002 100	Design filing fee	
1003 500	2003 250	Plant filing fee	
1004 250	2004 125	Rescue filing fee	
1005 100	2005 50	Provisional filing fee	
SUBTOTAL (1)			(\$)

**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1202 18	2202 9	Claims in excess of 20	
1201 84	2201 42	Independent claims in excess of 3	
1203 280	2203 140	Multiple dependent claim, if not paid	
1204 30	2204 15	** Reissue independent claims over original patent	
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)			(\$)

\*\* Reissue fees apply only if the original patent is not in force.

**FEE CALCULATION (continued)****3. ADDITIONAL FEES**

Large Entity Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee of utility	
1052 50	2052 25	Surcharge - late prosecution filing fee of utility	
1053 130	2053 65	Surcharge - late prosecution filing fee of design	
1012 2,520	2012 1,260	For filing a request for expedited examination	
1804 920	2804 460	Requesting publication of SAR prior to examination	
1805 1,040	2805 520	Requesting publication of SAR after examination	
1251 110	2251 55	Extension for reply within first month	55
1252 410	2252 205	Extension for reply within second month	
1253 910	2253 455	Extension for reply within third month	
1254 1,350	2254 675	Extension for reply within fourth month	
1255 1,910	2255 955	Extension for reply within fifth month	
1401 320	2401 160	Notice of Appeal	
1402 320	2402 160	Filing a brief to support an appeal	
1403 200	2403 100	For request for rehearing	
1451 1,510	2451 755	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to resume - unavailable	
1453 1,300	2453 650	Petition to resume - interrupted	
1501 1,300	2501 650	Utility exam fee (on request)	
1502 470	2502 235	Design exam fee	
1503 630	2503 315	Plant exam fee	
1460 130	2460 65	Petitions to the Commissioner	
1807 50	2807 25	Processing fee under 37 CFR 1.17(c)	
1806 100	2806 50	Submission of Information Disclosure Sheet	
8021 40	28021 20	Recording each patent document per property (times number of properties)	
1809 750	2809 375	Filing a submission after final rejection (37 CFR 1.120(a))	
1810 750	2810 375	For each additional invention to be examined (37 CFR 1.120(b))	
1801 750	2801 375	Request for Continued Examination (RCE)	
1802 900	2802 450	Request for expedited examination of a design application	
Other fee (specify)			
* Reduced by Basic Filing Fee Paid			
SUBTOTAL (3)			(\$)

**SUBMITTED BY**

Name and Title	Timothy J. Shea II
Signature	[Signature]

Registration No.  
(Attorney/Agent)

37,504

(Complete if applicable)

Telephone 781.237.2858

Date 23 March 2003

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

The collection of information is required by 37 CFR 1.17 and 1.22. The information is required to obtain or retain a benefit by the public which is to be (and) by the U.S. Patent and Trademark Office. Confidentiality is governed by 37 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FILES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**TIMOTHY J. SHEA II, ESQ.**  
REGISTERED PATENT ATTORNEY

396 Washington Street, Suite 322 - Wellesley, MA 02481

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*Date:* 25 September 2003*To:* M.Patterson  
U.S.P.T.O. Art Unit 3728*Telefax No.:* 1.703.872.9302*From:* Timothy J. Shea II, Esq.*U.S.S.N.* 10/086,509*Atty. Docket No.:* PURP01/0010*Pages (including this page):* 20*Please call the sender if you have any problems with this transmission.***THIS IS AN OFFICIAL DOCUMENT**



Atty.cket No. PURP01/0010

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In re Application of:	)	Art Unit: 3728
LOUIS J. PANACCIONE	)	Examiner: M. D. Patterson
Serial No. 10/086,509	)	
Filed: 28 February 2002	)	
For: MODULAR CUSHIONED	)	
INSOLE SUPPORT SYSTEM	)	

CERTIFICATE OF TRANSMISSION  
UNDER 37 C.F.R. 1.08

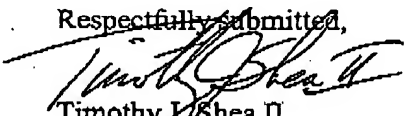
Date of Transmission: 25 September 2003

Identification of paper or fee: Amendment and Response A, Fee Transmittal, Form PTO-2038

*call customer  
re response*

I hereby certify that the above-identified paper to which this certification is attached is being transmitted by facsimile to the Patent and Trademark Office under 37 C.F.R. 1.8(a) in accordance with 37 C.F.R. §1.6(d) on the date indicated above and addressed to the Assistant Commissioner for Trademarks, Washington, D.C. 20231.

Respectfully submitted,

  
Timothy J. Shea II  
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0010-2/PUR-P01/certifax25sep03

Atty. Docket No. PURP01/0010

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of:

Art Unit: 3728

LOUIS J. PANACCIONE

Examiner: M.D. Patterson

Serial No. 10/086,509

Confirmation No. 2163

Filed: 28 February 2002

For: MODULAR CUSHIONED INSOLE SYSTEM)

MAR 24 2004

OFFICIAL

AMENDMENT AND RESPONSE ACommissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

Sir:

In response to the Office Action mailed 16 June 2003, please amend the above-referenced patent application as follows:

**Amendments to the Claims** are reflected in the listing of claims, which begins on page 2 of this paper.

**Amendments to the Drawings** are listed on page 7 of this paper and reference both the appended replacement sheet and annotated sheet showing changes.

**Remarks/Arguments** begin on page 8 of this paper.

**Appendix A** including both a replacement sheet of drawings and an annotated sheet showing changes to the amended drawing figures is attached following page 13 of this paper.

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Atty. Docket No. PURP01/0010

Page 2

**Amendments to the Claims:**

This listing of claims will replace all prior versions, and listings, of claims in the application:

**Listing of Claims:**

1. (currently amended) A modular cushioned insole support system intended for use ~~in connection with footwear,~~ within the interior of footwear to support a human foot having a forefoot and a heel, the system comprising:

a) a heel piece having a thickness underlying said heel and an upper and lower surface and further defining within said upper surface a first interlocking means, and

b) a forefoot piece ~~selected from a plurality of forefoot pieces having different widths, thicknesses, and impact cushioning characteristics,~~ and each having a dorsally disposed second interlocking means capable of being accommodated within said first interlocking means, wherein said heel piece is structured such that it is capable of correctively supporting said human foot in a neutral orientation, the assembled system and its components having a medial and a lateral side relative to the anatomic orientation of the system.

2. (original) The modular cushioned insole support system of Claim 1 further provided with means for retaining said second interlocking means within said first interlocking means.

3. (original) The modular cushioned insole support system of Claim 2 wherein said means for retaining is an adhesive.

4. (original) The modular cushioned insole support system of Claim 2 wherein said means for retaining is a mechanical fastener.

5. (original) The modular cushioned insole support system of Claim 2 wherein said first part of an interlocking means is a longitudinal channel.

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Atty. Docket No. PURP01/0010

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6. (original) The modular cushioned insole support system of Claim 2 wherein said second interlocking means is a tongue.

7. (original) The modular cushioned insole support system of Claim 1, wherein said forefoot piece has a hardness of 25 to 50 shore C.

8. (original) The modular cushioned insole support system of Claim 1, wherein said forefoot piece is provided with a cushioning means.

9. (original) The modular cushioned insole support system of Claim 8, wherein said cushioning means is selected from the group consisting of gel sacs, air sacs, elastomeric material, spongiform material, and resilient cushioning material.

10. (original) The modular cushioned insole support system of Claim 9, wherein said cushioning means is disposed such that it defines internal apertures that facilitate deformation in response to compressive forces and reformation when those forces are relieved.

11. (currently amended) The modular cushioned insole support system of Claim 8, wherein said cushioning means is further capable of initiating contains ingredients that are inert when isolated from each other and that when combined interact in an exothermic chemical reaction.

12. (original) The modular cushioned insole support system of Claim 1, wherein said heel piece is selected from a plurality of heel pieces each having a different width.

13. (currently amended) The modular cushioned insole support system of Claim 1, wherein said heel piece is selected from a plurality of heel pieces each having a different tortional cross-sectional geometry.

14. (original) The modular cushioned insole support system of Claim 1, wherein said heel piece has a hardness of 50 to 75 shore C.

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15. (currently amended) The modular cushioned insole support system of Claim 1, wherein said heel piece defines within said channel a centrally disposed aperture capable of accommodating a corresponding protuberance in said ~~tongue~~, forefoot piece, such that in use said protuberance is disposed within said aperture.

16. (original) The modular cushioned insole support system of Claim 1, wherein said system further comprises a heel cup disposed along said lower surface of said heel piece such that said heel piece is partially supported by said heel cup.

17. (original) The modular cushioned insole support system of Claim 16, wherein said heel cup is disposed along said lateral side of said heel piece.

18. (original) The modular cushioned insole support system of Claim 16, wherein said heel cup is disposed along said medial side of said heel piece.

19. (original) The modular cushioned insole support system of Claim 1, wherein said forefoot piece has a perimeter and a centrally disposed foot accommodation means with a transition zone therebetween.

20. (currently amended) The modular cushioned insole support system of Claim 19, wherein said transition zone ~~between~~ is relatively abrupt.

21. (currently amended) The modular cushioned insole support system of Claim 19, wherein said forefoot piece has a first thickness disposed about said ~~foot accommodation means~~ perimeter transitioning to a second thickness in the region of said foot accommodation means.

22. (original) The modular cushioned insole support system of Claim 21, wherein said transition between said first thickness and said second thickness is tapered such that a foot may be cradled within said foot accommodation means.

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23. (currently amended) A modular cushioned insole support system intended for use in connection with footwear, the system being arranged as a kit and comprising:

- a) a plurality of forefoot pieces having different widths, thicknesses, and impact cushioning characteristics, with a durometer range of 25 to 50 shore C, and each defining a first interlocking means
- b) a plurality of heel pieces having a durometer range of 50 to 75 shore C and each defining a second interlocking means and further structured such that each supports said human foot in a position selected from the group consisting of neutral orientation, anti-pronation orientation, and anti-supination orientation.

whereby a consumer selects and assembles one of said forefoot pieces and one of said heel pieces by engaging said first and second interlocking means to form a custom insole.

24. (new) The modular cushioned insole support system of Claim 1, wherein said forefoot piece is selected from a plurality of forefoot pieces having different widths, thicknesses, and impact cushioning characteristics.

25. (new) The modular cushioned insole support system of Claim 1, wherein said forefoot piece is capable of ensuring the proper fit of a narrower foot within a wider footwear that is correctly sized for a wider foot.

26. (new) The modular cushioned insole support system of Claim 1, wherein said heel piece is capable of anti-pronation correction of the orientation of said foot within said footwear to enable neutral orientation of said foot within said footwear.

27. (new) The modular cushioned insole support system of Claim 1, wherein said heel piece is capable of anti-supination correction of the orientation of said foot within said footwear to enable neutral orientation of said foot within said footwear.

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28. (new) The modular cushioned insole support system of Claim 1, wherein said heel piece is selected from a group of heel pieces having different said thicknesses, such that different leg lengths may be corrected for.

29. (new) A modular cushioned insole support system intended for use in the interior of footwear, the system comprising:

- a) a heel piece having an upper and lower surface and further defining within said upper surface a first interlocking means, and
- b) a forefoot piece having a dorsally disposed second interlocking means capable of being accommodated within said first interlocking means, such that said forefoot piece does not extend the full length of said footwear interior and does not extend the full width of said footwear interior throughout the length of said forefoot piece.

the assembled system and its components having a medial and a lateral side relative to the anatomic orientation of the system.

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Atty. Docket No. PURP01/0010

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**Amendments to the Drawings:**

Appendix A contains a replacement sheet of drawings includes changes to Fig. 5. This sheet, which includes Figs. 5A and 5B, replaces the original sheet including Figs. 5A and 5C. In Figure 5A, previously mislabeled line C-C' has been correctly identified as B-B'. Appendix A further contains an annotated sheet showing the changes made.



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### REMARKS

The Examiner is thanked for the thoroughness of the Office Action. The claims have been carefully reviewed in light of the rejections contained therein. Reconsideration of the application in view of the foregoing amendments and the following remarks is respectfully requested.

In amended Figure 5, the previously mislabeled line C-C' has been corrected to B-B' and previously mislabeled Figure 5C properly relabeled as 5B. Figure 5 was previously thus amended in a Preliminary Amendment submitted on 5 September 2002. Although Applicant believes the amendments made therein to have been in proper format for entry under the rules then in force for making amendments to the drawings, in an abundance of caution Applicant resubmits in Appendix A hereto amendments to Figure 5 consistent with, and in the format required by, the amended rules currently in force.

Claims 1-22 remain in this application. Claims 1, 11, 13, 15, 20-21, and 23 have been amended. Claims 24-29 have been added.

Claims 1-22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "selected from a plurality..." has been deemed to be vague and indefinite because it is not clear if applicant is positively reciting and claiming a single forefoot piece or a plurality of forefoot pieces. Claim 1 has been amended and claim 24 added to more positively recite and claim this aspect of the present invention. Applicant respectfully submits that the amendment overcomes the rejection and respectfully requests reconsideration and withdrawal thereof.

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In claim 11, the phrase "capable of initiating..." is deemed to be functional, indefinite, and incomplete because it contains functional language not supported by recitation in the claim of sufficient structure to warrant the presence of such language. The Office Action stated that it is not clear what structural limitations applicant intends to encompass with such language. Claim 11 has been amended to more positively recite and claim the invention. Applicant respectfully submits that the amendment overcomes the rejection and respectfully requests reconsideration and withdrawal thereof.

In claim 13, the phrase "torsional geometry" has been deemed to be confusing, vague, and indefinite. Claim 13b has been amended to more positively recite and claim the invention. Applicant respectfully submits that the amendment overcomes the rejection and respectfully requests reconsideration and withdrawal thereof.

Claims 1, 2, 4-6, 8-10, 12, 13, and 15 are rejected under 35 U.S.C. § 102(e), as being clearly anticipated by *Erickson* (U.S. Pat. No. 6,408,543). The Office Action states that *Erickson* shows an insole comprising a heel piece (24), a forefoot piece (22), interlocking and retaining means (26, 42, 58, 25b, and 59), and a forefoot cushioning means (27), as claimed.

Applicant respectfully submits that *Erickson* requires that the solepad include a cushioning structural element, such as a filled bladder, in the region underlying the ball of the foot. The device of the present invention contains no such limitation. Claim 1 has been amended to clarify that no such cushioning function is necessary for the forefoot piece of the present invention. Rather, the present invention permits use of a forefoot piece having no, or negligible, cushioning effect.

Applicant respectfully submits that the point of invention of the present invention resides in the capability of the assembled device to support the foot in a neutral orientation. Significant wear and tear of both shoes and anatomy result from "fallen arches," more properly known as

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pronation of the foot, and also of its opposite: supination. Furthermore, different leg lengths and foot widths are more common than not.

Because most individuals have one foot that is up to a half size wider than the other, only one foot may properly be accommodated by most footwear. Thus, either the wider foot is squeezed into a narrower shoe, or a narrower foot must slide around in a wider shoe. The present invention enables a user to use a standard forefoot piece for use with the wider foot and a thicker forefoot piece that occupies more volume in the footwear for the narrower foot. Thus, both feet are properly accommodated within footwear having a width comfortable for the wider foot. By selecting the correct combination of forefoot and heel pieces, a user of the device of the present invention may correct all of these conditions.

Likewise, most individuals have one leg that is slightly shorter than the other. This may result in significant back problems, as the pelvis must rotate to functionally equilibrate leg length while standing, walking, or running. However, this situation may be corrected in a device of the present invention by the user selecting for the shorter leg a heel piece that is slightly thicker in the region underlying the heel.

In addition to the above distinctions, the solepad of *Erickson* extends substantially the length of the human foot (see col. 1, lines 24-26) and also substantially the full width of the foot throughout its length. In sharp contradistinction, the device of the present invention may comprise a forefoot piece and a heel piece that extend the full length and width of the human foot only when joined together. Claim 29 has been added to make clear the distinction that the forefoot piece of the present invention is not required to extend the full length of the foot and the full width of the foot throughout the length of the forefoot piece.

Claims 1, 2, 5, 6, 8, and 16-18 are rejected under 35 U.S.C. § 102(b), as being anticipated by *Torchia* (U.S. Pat. No. 1,733,678). The Office Action states that *Torchia* shows an insole

lines 7-10.) The device of *Torchia* comprises a supporter having a plurality of laterally disposed pockets into which various structural support elements may be partially inserted. In contrast, the present device extends throughout the length of the foot and is intended to optimize the fit of the shoe, in addition to optionally providing cushioning and support. The device of the present invention does not comprise laterally disposed pockets, nor may any of the elements of the present invention be partially inserted into the periphery of any other element(s). For these reasons, and in light to the amendments to the claims, Applicant respectfully requests reconsideration and withdrawal of the rejection based on *Torchia*.

Claims 1, 2, 4-6, 8-10, and 19-22 are rejected under 35 U.S.C. § 102(b), as being anticipated by *MacNamara* (U.S. Pat. No. 6,092,311). The Office Action states that *MacNamara* shows an insole comprising a heel piece (20) with first interlocking means (64, see column 4, lines 20-25), forefoot pieces (30, 40, and 50) some with a forefoot centering periphery (shown in figures 1A and 1B), and second interlocking means (62), as claimed.

Applicant respectfully submits that *MacNamara* relates to a series of progressively sized unitary insoles that may be attached to the interior surface of the shoe outsole. These insoles are intended to enable parents to buy a larger size shoe for their child, yet optimize the fit of the shoe as the child grows. These insoles may be provided with interlocking means that matcably engage corresponding means provided along the interior surface of the shoe outsole. In contrast, the present device comprises a forefoot piece and a heel piece and the interlocking means is designed

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such that each of these pieces may engage each other, not the outsole of the shoe. For these reasons, and in light to the amendments to the claims, Applicant respectfully requests reconsideration and withdrawal of the rejection based on *MacNamara*.

Claims 3, 7, 14, and 23 are rejected under 35 U.S.C. § 103(a), as being unpatentable over *Erickson or Torchia*. The Office Action states that, "*Erickson* shows an insole substantially as claimed except for the exact means for retaining the interlocking means together and the exact material hardnesses. The use of adhesive to retain elements together is well known and conventional and also low tack adhesives are a well known alternative to hook and loop fasteners. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416." The Office Action further states that, "it would have been obvious to provide adhesive and to use materials with hardnesses as claimed in the insole of either *Erickson or Torchia* to prevent the elements from sliding apart and to provide appropriate support and durability materials."

Applicant respectfully re-emphasizes that the patentability of the presently claimed invention does not reside in the exact means for retaining the interlocking means together or to the exact material hardnesses, but, rather, by the unexpected performance characteristics attained at reasonable cost by the device claimed. There is no suggestion in any pertinent reference, either alone or in combination with another, that the unexpected performance levels and ancillary benefits achieved by the presently claimed invention are possible in a commercially viable sockliner. For these reasons, and the points presented above with reference to the rejections made under 35 U.S.C. § 102, Applicant believes his invention as claimed to be in condition for allowance and respectfully requests such action.

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Claim 11 is rejected under 35 U.S.C. § 103(a), as being unpatentable over either *Erickson* or *Torchia* in view of *Dahle* (U.S. Pat. No. 5,230,170). The Office Action states that, "*Erickson* or *Torchia* shows an insole substantially as claimed except for a chemically reactive forefoot pad. *Dahle* teaches providing a chemically reactive forefoot pad (42) in an insole. It would have been obvious to provide a chemically reactive forefoot pad as taught by *Dahle* in the insole of either *Erickson* or *Torchia* to provide warmth to the foot in cold weather."

The rejection of claim 11 under 35 U.S.C. § 103 is based on the combination of the references cited above. Applicant maintains that such a combination would not be obvious to one of ordinary skill in the art. Indeed, even if the references are combined, the claimed invention is not achieved. Applicant respectfully submits that, for the reasons stated above, the presently claimed apparatus is patentable over both *Erickson* and *Torchia*, and, for these reasons, claim 11 is likewise patentable.

Accordingly, Applicant believes his invention as claimed to be in condition for allowance and respectfully requests reconsideration and withdrawal of the outstanding rejections and that a timely Notice of Allowance be issued in this case. If any questions remain, please contact Applicant's attorney, Timothy J. Shea II, collect at the number given below.]

Respectfully submitted,

LOUIS J. PANACCIONE, Applicant



Timothy J. Shea II, Esq.  
Reg. No. 27,504  
Applicant's Attorney

Dated: 25 September 2003

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Wellesley, MA 02481  
781.237.2858

0010-2/PUR-P01/RcpA

**APPENDIX A**

A-1

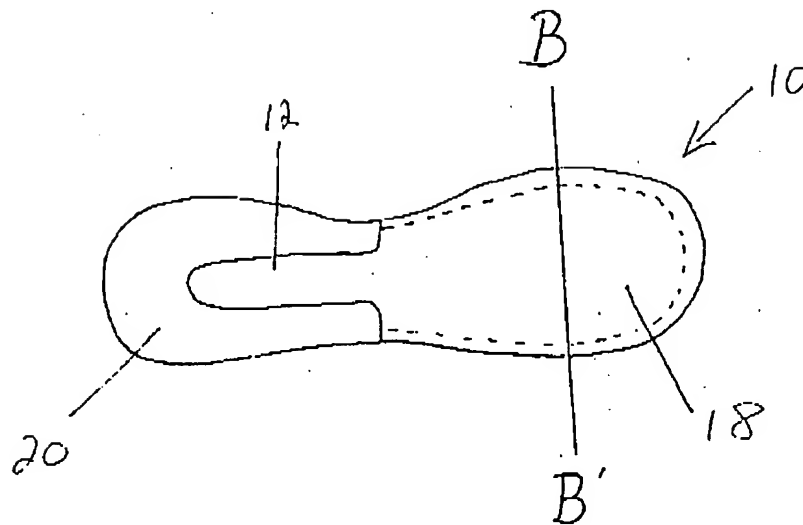


Fig 5A

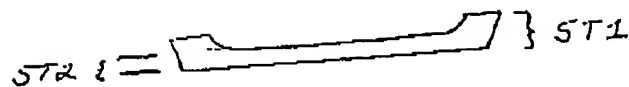
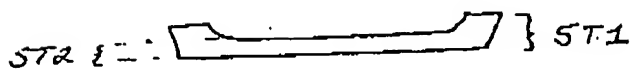
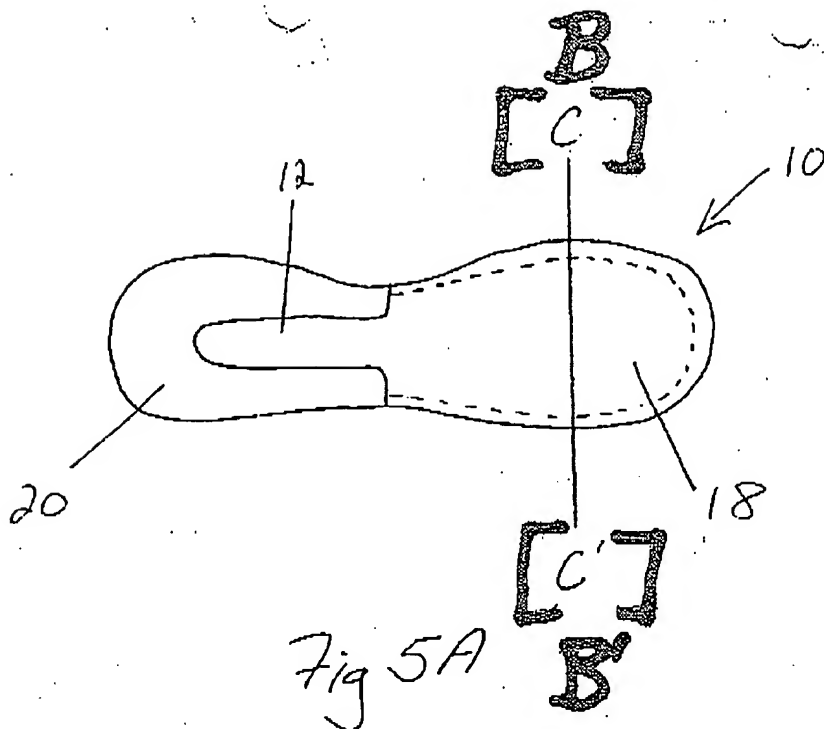


Fig 5B



[Fig 5C]  
Fig 5B



EXHIBIT 2

4

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U.S.P.T.O. Art Unit 3728

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From: Timothy J. Shea II, Esq.

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